

Remarks

Claims 2, 11, 14-16, 18-20, 23, 26-33 and 35 have been indicated to recite allowable subject matter. Applicants greatly appreciate the indication of allowable subject matter in the present application.

Applicants hereby add claims 36-40. Accordingly, claims 1-4, 6-11, 14-16, 18-21, and 23-40 are pending in the present application.

Claims 21 and 34 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 6,665,089 to Austin et al. Claims 1, 3-4, 6-7, and 9-10 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 6,641,244 to Dougherty et al. Claims 8, 21, and 25 stand rejected under 35 USC 103(a) for obviousness over Dougherty in view of U. S. Patent No. 5,148,218 to Nakane et al. Claims 1, 6, 8-10, and 24-25 stand rejected under 35 USC 103(a) for obviousness over Austin in view of Japanese Patent No. 2001249504A to Asai.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to claim 1, the device comprises processing circuitry configured to control storage of data using a memory to provide a history comprising *a plurality of values of at least one environmental condition* to which the device has been *exposed at a plurality of different moments in time*. Applicants respectfully assert that claim 1 recites allowable subject matter over the prior art.

The teachings of Dougherty are clear that if ECs have not changed, the EP process may be performed utilizing previously measured ECs. Alternatively, if an EC has changed, the EP process may be modified. There is no teaching in Dougherty of storage of a history comprising a plurality of values of at least one environmental condition to which the device has been exposed at a plurality of different moments in time as claimed. There is no suggestion to modify Dougherty to control storage of data using a memory to provide the history comprising the plurality of values of the at least one environmental condition inasmuch as Dougherty is only concerned with utilization of a current or unchanged EC status and is not concerned with providing plural values of the environmental condition at different moments in time as claimed. Claim 1 recites limitations not disclosed nor suggested by Dougherty and claim 1 is allowable thereover for at least this reason.

Referring to the 103 rejection of claim 1, Applicants respectfully submit that

Serial No. 10/016,317  
Case No. 10016586-1  
Amendment E

there is no motivation to combine the teachings of Asai with the teachings of Austin and the rejection is improper for at least this reason.

More specifically, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed., rev. 2).

On page 6 of the Action, the Office correctly notes that Austin fails to disclose limitations of claim 1. The Action states on page 6 that the combination of references is appropriate so that optimal images can be obtained with a new replenishment of toner. Applicants respectfully submit that the alleged motivation fails to support a proper 103 rejection.

More specifically, referring to col. 1, line 66 - col. 2, line 14 of Austin, it is clear that such reference is concerned with imaging in different environments and making adjustments responsive to the environment in which the device currently operates (i.e., increasing force when used in cold environments). Austin is only concerned with real time measurements and modifications to accommodate different real time environments of operation. Accordingly, there is no desire or usage in Austin of storage of a *history comprising a plurality of values of at least one environment condition at a plurality of different moments in time* as claimed.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on *objective* evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on

subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is void of any evidence to support motivation to combine the teachings. Applicants have provided above a compelling argument *based upon the prior art teachings* regarding the lack of motivation to combine reference teachings. As set forth by the Federal Circuit, Applicants respectfully submit there is no motivation and the Office Action has failed to establish a prima facie case of obviousness and accordingly the 103 rejection is improper.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the obviousness rejection of independent claim 21 and dependent claims 8 and 25, Applicants submit a Statement of Common Ownership herewith. Applicants respectfully request withdrawal of the 103 rejection of claims 8, 21 and 25 pursuant to MPEP §706.02(I)(2) (8<sup>th</sup> ed., rev. 2) in view of the submission of the enclosed Statement.

Referring to the anticipation rejection of claim 21, Applicants respectfully submit that Austin fails to disclose or suggest limitations of the claimed device and claim 21 is allowable for at least this reason.

Initially, there is no teaching or suggestion in Austin of the interface configured to *communicate the data indicative of the environmental condition externally of the image forming device* as claimed. Although the teachings in Fig. 23 and col. 15 of Austin may disclose measuring of an environmental condition using a computer, there is no teaching or suggestion that the condition is communicated to the printer. For example, the computer may determine a printer setting using the environmental condition and only communicate the printer setting to the printer as opposed to communication of the condition to the printer. The above limitation of claim 21 is not disclosed nor suggested by the prior art and claim 21 is allowable for at least this reason.

Claim 21 further recites an *internal power source configured to provide*

Serial No. 10/016,317

Case No. 10016586-1

Amendment E

*power to the sensor* in an absence of power from a source external of the device. Austin discloses that the battery 1224 may provide power to hardware system 1200 and printer 100 during portable operations. However, *Austin is void of any teaching or suggestion of the battery supplying power to the sensor* as claimed. Applicants have failed to uncover any teachings in Austin of the battery providing power to the sensor during portable operations as claimed. In fact, it would be desirable to reduce power consumption of the device of Austin during portable operations. Applicants respectfully submit that Austin fails to disclose or suggest limitations of claim 21 and claim 21 is allowable for at least this reason.

The claims which depend from independent claim 21 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 34 it is stated that the interface is configured to output data indicative of the at least one environmental condition externally of the image forming device. The Office recites teachings of Fig. 23 and col. 15 of Austin of the computer measuring an environmental condition. However, even if the conditions are communicated to the printer, the teachings fail to disclose or suggest the claimed *outputting* of data indicative of the at least one environmental condition *externally of the image forming device* as claimed. Positively-recited limitations of claim 34 are not disclosed nor suggested by the prior art and claim 34 is allowable for at least this reason.

Applicants hereby add new claims 36-38 which correspond to respective dependent claims 2, 29, and 31 and the respective independent claims from which they depend. Applicants respectfully submit that the new claims are in condition for allowance in view of the allowable subject matter indicated in the Action. Support for new claims 39-40 may be found at Fig. 2 and the associated specification teachings of the originally filed application.

The amendments made herein now more positively express limitations which were previously inherent in such claim(s), and accordingly are not for the purpose of narrowing and do not effectively narrow the scope of any claim.

Applicants submit herewith an Information Disclosure Statement.

Applicants respectfully request allowance of all pending claims.

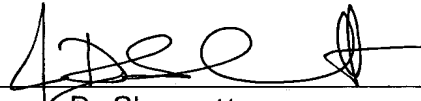
Serial No. 10/016,317  
Case No. 10016586-1  
Amendment E

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Srinivas Guddanti  
Chet Butikofer

By:

  
James D. Shaurette  
Reg. No. 39,833  
Date: 2/28/05